

Serial No. 10/603,487

Pre-Appeal Brief Request for Review

UTILITY PATENT

B&D No. JK01493

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Jaime GARCIA et al.**

Serial No.: **10/603,487**

Examiner: **P. Nguyen**


Filed: **June 25, 2003**

Group Art Unit: **3724**

For: **FRONT BEVEL INDICATOR/FRONT BEVEL LOCK**

Assistant Commissioner for Patents
Washington, DC 20231

PRE-APPEAL BRIEF REQUEST FOR REVIEW

I, Adan Ayala, Reg. No. 38,373, certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 12-14-06 

Dear Sir:

This is in response to the final Office Action of August 22, 2006. A Notice of Appeal has been filed herewith.

Applicants request that the rejection in the present case be withdrawn.

Currently in the above-identified application therefore are Claims 50 and 55-58.

The Examiner has rejected Claims 50 and 55-58 under 35 USC § 112, first paragraph, for failing to comply with the enablement requirement. In particular, the Examiner notes that "it is unclear how the rotatable shaft can move 'towards the front portion of the miter base and towards the rear portion' since "gears 50 and 30 are fixedly attached to both ends of the shaft 40 [and thus] the shaft 40 cannot be pulled toward the front portion of the miter saw."

Applicants admit that gears 30 and 50 are fixedly attached to both ends of the shaft 40, allowing shaft to translate the rotational angle of the bevel housing in the rear portion to the bevel

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indicator in the front portion.¹ Spec., para. 0016. Arm 90 has cammed surfaces 110 which push against output translation gear 50, moving it towards the front of the miter saw. Spec., para. 0028. Since output translation gear 50 is fixedly attached to transverse shaft 40, shaft 40 is also moved towards the front portion of the miter base. When the pressure from cammed surfaces 110 against the output translation gear 50, the gear 50 (and thus the shaft 40) move towards the rear portion.

Because of a person skilled in the art can practice the claimed invention by implementing the subject matter described in the specification and shown in the figures, the person skilled in the art will not need to conduct undue experimentation. Therefore, the claims are properly enabled.

While the Examiner agrees that the cammed surfaces 110 push against the output translation gear 50, the Examiner however does not believe that “the output translation gear 50 will move toward the front of the miter saw due to the act of pushing of the cammed surfaces since the output translation gear is fixedly held in a slot of a front gear housing as shown in Figs. 2 and 4.” In particular, the Examiner points to FIG. 4 and shows that “there is no room for the translation gear 50 [to move] forward which leads to the forward movement of the shaft 40.” In other words, the Examiner is arguing non-enablement because the drawings do not show a sufficient gap.

The “test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without

¹ Applicants do not understand why the Examiner believes that tolerance exists between the shaft 40 and gears 30, 50 allowing any sliding motion therebetween, as the Specification explicitly states that “[a]t the rear end of the transverse shaft 40, an input translation gear 30 is secured by securing means 32, 33” and that “[a]t the front end of the transverse shaft 40, an output translation gear 50 is secured by securing means, such as a pin 52 and a washer 51.” Spec., para. 0016 and FIG. 1.

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undue experimentation.” *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988).

The Examiner must consider many factors to determine whether any necessary experimentation is undue. These factors include, but are not limited to: (A) the breadth of the claims; (B) the nature of the invention; (C) the state of the prior art; (D) the level of one of ordinary skill; (E) the level of predictability in the art; (F) the amount of direction provided by the inventor; (G) the existence of working examples; and (H) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988); MPEP § 2164.01(a). The Examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. *Wands*, 858 F.2d at 737, 740.

In the present case, it appears that the Examiner has not conducted any analysis of these factors, as he failed to disclose such analysis. Had the Examiner conducted any such analysis, he would have found that: (a) the claims cover an improvement for miter saws (factors A-B); (b) the table saw field has been active since at least 1928² (factor C); (c) the level of people of ordinary skill is high as the person of ordinary skill is a power tool engineer that attended engineering school and understands mechanical concepts (factor D); (d) the level of predictability in the art is high as to the effect of more or less play between components affecting motion between the components (factor E); and (e) a working example exists, as one of the embodiments ultimately became commercially available (factor G).

² See, e.g., US Patent No. 1,758,623.

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As to factor F (the amount of direction provided by the inventor), the specification reads as follows:

An arm 90 of the handle engages the bevel scale axis shaft 100 to lock out motion or free the bevel of tiltable support 130 to rotate. In an embodiment, the transverse shaft 40 is used as a lock by pulling it forward (i.e., away from the front of the miter) via the cammed surfaces 110 on the arm 90 against output translation gear 50 so that the transverse shaft 40 is placed in tension and is unable to rotate.

Specification, para. 0028. Accordingly, the inventors have told the persons of ordinary skill in the art what the desired result is and provided an embodiment teaching how to achieve such result. Therefore, there is considerable direction and guidance in the specification.³

As to factor H (the quantity of experimentation needed to make or use the invention), the quantity of experimentation would be low. The one issue the Examiner identified, i.e., the amount of play needed to allow relative movement, is one where a person skilled in the art would quickly resolve without experimentation. The person skilled in the art would just need to determine how much translational movement was desired and then provide enough play, or space between components, to allow such movement.

This is the same analysis everyone goes through when mailing a present: I need to put a toy in a mailing box; therefore I need a box that is larger, not smaller, than the toy. The larger the box, the easier it will be to put the toy inside. Similarly, if the engineer decides she wants 1

³ The Examiner basically argues that the drawings do not show any play and that thus the person of ordinary skill has not received the appropriate guidance. This argument however would contradict the Federal Circuit's position on drawings: "[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue." *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956 (Fed. Cir. 2000). In the present case, the specification does not state that the drawings define the precise proportions of the elements.

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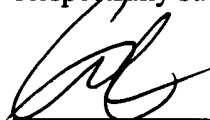
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cm of available translational movement, she will put more space between the components than if the desired translational movement was 1 mm.

Such level of experimentation is much lower than what has already been found to be reasonable by the Federal Circuit. In *Telectronics*, 857 F.2d 778, the court found that the amount of experimentation in that case (approximately \$50,000 and 6-12 months) was not undue. In the present case, no experimentation is required once the engineer has decided on the desired parameters.

Accordingly, all the factors to consider under *Wands* point to the conclusion that the specification is enabling. Therefore, Claims 50 and 55-58 are enabled and should be allowed.

Respectfully submitted,



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Therefore, the Examiner cannot use the drawings as evidence of the precise proportions of the elements.